

REMARKS

Entry of this Amendment is proper because it narrows the issues on appeal and does not require further searching by the Examiner.

Claims 1-20 are all the claims presently pending in the application. Claims 3 and 6-15 have been restricted from prosecution. Claim 19 has been amended to further define the invention.

Applicant gratefully acknowledges the Examiner's indication that claims 1, 2, 4, 5 and 16-18 are allowed. However, Applicant respectfully submits that all of the claims are in condition for allowance.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Allen et al. (U. S. Patent No. 5,737,491) in view of Kimoto et al. (U. S. Patent No. 6,115,611).

This rejection is respectfully traversed in view of the following discussion.

I. THE CLAIMED INVENTION

The claimed invention (e.g., as recited in claim 19) is directed to an electronic camera which includes a communication device which transmits a request for an image to a server through an external communication device in a wireless communication network, the external communication device determining a communication area in which the external communication device is located and sending information identifying the communication area to the server, and receives in the camera, information and the image from the server through the external communication device, the image being selected by the server based on the information

identifying the communication area.

Conventional cameras may record positional information on the basis map information previously recorded on a recording medium. However, since the quantity of the map information is limited, a user is often unable to obtain positional information except in certain limited places (Application at page 1, line 22-page 2, line 3).

The claimed invention, on the other hand, includes a communication device which in the camera, receives information and the image from the server through the external communication device (Application at Figure 2; page 2, line 2-page 3, line 10). Thus, unlike conventional cameras, the camera does not need to record map information in order for the camera to obtain positional information (e.g., information regarding the camera's location).

II. THE FINALITY OF THE OFFICE ACTION IS PREMATURE AND SHOULD BE WITHDRAWN

Applicant notes that MPEP 706.07(a) provides that "second or any subsequent actions on the merits shall be final, except where the examiner **introduces a new ground of rejection** that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement .." (emphasis added).

Applicant notes that the Office Action includes a new ground of rejection (e.g., Allen in view of Kimoto) which was **not necessitated by amendment**. That is, although claims 19 and 20 were added by the Amendment filed herein on July 26, 2005, these claims include features that the Examiner alleged were disclosed by Squilla (U. S. Patent No. 6,396,537) in the Office Action dated May 5, 2005.

Thus, contrary to the Examiner's allegations, the addition of claims 19 and 20 did not necessitate the new ground of rejection.

Therefore, the finality of the Office Action is premature and should be withdrawn.

**III. THE RESTRICTION REQUIREMENT; THE OFFICE ACTION IS
INCOMPLETE**

First, with respect to claims 10-15, Applicant would point out that the Examiner has indicated on the Office Action Summary page that claims 10-15 are withdrawn from consideration.

However, nowhere in the body of the Office Action does the Examiner ever explain why. Indeed, the Examiner does not allege that claims 10-15 are directed to an unelected invention and certainly does not provide any support for restricting these claims from prosecution.

Applicant would remind the Examiner that the Examiner must provide some grounds for restricting claims from prosecution. The Examiner cannot just restrict claims from prosecution on a whim and leave Applicant to guess at why the claims have been restricted from prosecution.

Therefore, the Examiner must provide Applicant with another non-final Office Action indicating why claims 10-15 have been withdrawn from prosecution, and providing some support for the Examiner's actions.

Further, with respect to claims 3 and 6-9, the Examiner maintains the restriction requirement which was included in the Office Action dated June 21, 2004 and the Office Action of May 5, 2005, restricting claims 3 and 6-9 from prosecution. Applicant respectfully submits, however, that the restriction requirement is not proper.

Applicant AGAIN would point out that the Examiner has failed to make a *prima facie* showing that examining Groups II and III (claims 3 and 6-9) would place a serious burden on the Examiner. Further, even though the Examiner has alleged that Groups I-III may be classified in different subclasses, Applicant has sufficiently rebutted the Examiner's arguments by pointing out that the Examiner's search with regard to Groups II and III would be coextensive with his examination of Group I.

Moreover, even assuming (*arguendo*) that there is some additional burden caused by examining Groups II and III in addition to Group I, the burden is very slight and greatly outweighed by the serious financial burden placed on Applicant by restricting out the claims of Groups II and III such that Applicant is required to file Divisional Applications directed to the

claimed invention of Groups II and III.

Therefore, Applicant respectfully requests that the Examiner withdraw the restriction requirement and examine all of the claims 1-20 presently pending in the present Application.

III. THE ALLEGED PRIOR ART REFERENCES

The Examiner alleges that Allen would have been combined with Kimoto to form the invention of claims 19 and 20. Applicant submits however, that these alleged references would not have been combined and even if combined, the combination would not teach or suggest each and every feature of the claimed invention.

Allen discloses a digital camera 10 which includes a wireless transceiver 32 for transmitting images

Kimoto discloses a mobile communicating system having a mobile terminal with a position information detecting unit.

However, Applicant submits that these references are completely unrelated, and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

In fact, Applicant submits that the references provide no motivation or suggestion to urge the combination as alleged by the Examiner. Indeed, these references clearly do not teach or suggest their combination. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

However, neither Allen nor Kimoto, nor any alleged combination thereof teaches or suggests a camera having a communication device which "*in said camera, receives information and the image from the server through said external communication device*", as recited in claim 19.

As noted above, unlike conventional cameras in which the quantity of the map information recorded on a recording medium is limited, the claimed invention includes an electronic camera including a communication device which in the camera, receives information

and the image from the server through the external communication device (Application at Figure 2; page 2, line 2-page 3, line 10). Thus, unlike conventional cameras, the camera does not need to record map information in order for the camera to obtain positional information (e.g., information regarding the camera's location).

For example, an exemplary embodiment of the claimed invention allows the camera to receive information on (e.g., regarding) the tourist spot around the communication area of the external communication device (Application at page 8, line 6-page 10, line 21). Thus, for example, when the external communication device is located in the area of Mt. Fuji, the camera may receive information on Mt. Fuji. Nowhere are these novel features taught or suggested by the prior art.

Clearly, these features are not taught or suggested by the cited references. Indeed, the Examiner essentially concedes that Allen does not teach or suggest these features on page 3 of the Office Action.

Specifically, the Examiner attempts to equate the wireless transceiver 32 with the communication device of the claimed invention. This is clearly incorrect.

In fact, the transceiver 32 in Allen is simply used to transmit images captured in the camera 10 to a server 34 for printing (Allen at col. 1, lines 57-65), **not for receiving images in the camera from the server**. Allen states that the transceiver 32 “is a wireless communication system such as a cellular telephone” (Allen at col. 3, lines 5-7). Allen states that the “digital images and appended control signals are transmitted to the image fulfillment server 34 by transceiver 32” (Allen at col. 4, lines 23-25). This is the only function of the transceiver 32.

Indeed, Applicant would respectfully point out that the Examiner has not identified an external communication device in Allen. Applicant respectfully submits that Allen does not teach or suggest such an external communication device as in the claimed invention and, certainly, does not teach or suggest that the transceiver 32 receives in the camera 10, information and an image from the server 34 through an external communication device.

Further, neither are these features taught or suggested by Kimoto. Indeed, as noted above, Kimoto simply discloses a mobile communicating system having a mobile terminal with a

position information detecting unit. Kimoto has nothing to do with a camera and in fact does not even mention a camera therein. Thus, Kimoto clearly does not teach or suggest a communication device which in a camera, receives information and an image from a server through an external communication device.

Therefore, Kimoto clearly does not make up for the deficiencies of Allen.

Therefore, Applicant submits that these alleged references would not have been combined and even if combined, the combination would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-20, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,



Phillip E. Miller, Esq.
Registration No. 46,060

McGinn IP Law Group, PLLC
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254